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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,680	10/26/2001	Richard N. Terry	02706-0421 (42276-265479)	3031

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JOHN S. PRATT, ESQ  
KILPATRICK STOCKTON, LLP  
1100 PEACHTREE STREET  
SUITE 2800  
ATLANTA, GA 30309

EXAMINER

ROBERTSON, JEFFREY

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/887,680

Applicant(s)

TERRY ET AL.

Examiner

Jeffrey B. Robertson

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 59-149 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 86-91, 94-98, 100-103, 125-135, 138-142 and 144-148 is/are allowed.
- 6) ☒ Claim(s) 59, 66, 67, 76, 81, 92, 93, 99, 104-106, 108-117, 123, 124, 136, 137, 143 and 149 is/are rejected.
- 7) ☒ Claim(s) 60-65, 68-75, 77-80, 82-85, 107 and 118-122 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 59, 99, 104-106, 108-117, 123, 124 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over 4, 47, 5-7, 9-18, 20, and 33 of Terry et al. (U.S. Patent No. 6,329,488) respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because

For claim 59 and claim 4 of '488, the only difference is that component i) of claim 59 includes the word "molecules", where component (2) of claim 4 contains the word "polymer". Polymers of claim 4 fall within the scope of the word molecules set forth in claim 59.

Art Unit: 1712

For claim 99 and claim 47 of '488, although the independent claims from which the two claims depend are different, the copolymer claimed in claims 99 and 47 is the same.

For claim 104 and claim 5 of '488, the only difference is the "consisting essentially of" and "comprising" transitional phrases, otherwise, the claims are identical.

For claims 105-117, 123, and 124, the corresponding claims in the '488 patent, 6, 7, 9-18, 20, and 33 are identical.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 66, 67, 76, 81, 92, 93, 99, 111, 112, 136, 137, 143, and 149 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 66, 67, 76, 81, 92, 93, 99, 111, 112, 136, 137, 143, and 149, the molecular weight of the polyethylene glycol is not identified as weight average or number average in the claims.

***Allowable Subject Matter***

5. Claims 59, 99, 104-106, 108-110, 113-117, 123, 124 would be allowable if rewritten or amended to overcome the double patenting rejection set forth in this Office action.

Art Unit: 1712

6. Claims 60-65, 68-75, 77-80, 82-85, 107, and 118-122 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claims 86-91, 94-98, 100-103, 125-135, 138-142, and 144-148 are allowed.
8. Claims 66, 67, 76, 81, 92, 93, 99, 136, 137, 143, and 149 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
9. Claims 111 and 112 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and the double patenting rejection, set forth in this Office action.

#### ***Response to Arguments***

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The statutory double patenting rejection has been changed to an obviousness-type double patenting rejection in light of applicant's cancellation of the previously pending claims. The rejection made under 102(e) is withdrawn in light of applicant's cancellation of the previous claims, the new claims do not read on this reference.

Art Unit: 1712


**Conclusion**

11. This reaction is made non-final due to the new rejection made under 112 second paragraph. Even though the claims rejected are newly presented by applicant, the issue of the type of molecular weight has not been previously raised for the claims, especially with respect to the parent application 09/189,240.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR